

Remarks/Arguments:

Claims 3-5 previously presented are pending.

Claims 1-2 are canceled, without prejudice or disclaimer.

Claims 3-5 are rejected under 35 U.S.C. §101 as allegedly directed to non-statutory subject matter and as being directed to non-statutory subject matter because the claims are method or process claims that do not transform underlying subject matter. Reconsideration is requested.

The rejection cannot be maintained because it relies on overturned case law, specifically the line of Federal Circuit decisions most recently the decision *In re Bilski*, 88 USPQ2d 1385 (Fed. Cir. 2008). The United States Supreme Court has just ruled that the Federal Circuit test for method or process claims, as held in the Federal Circuit Bilski decision, is not the exclusive test to determine satisfaction of §101. *Bilski v. Kappos*, ____ U.S. ____ (2010). In Bilski, the Supreme Court found that the machine-or-transformation test is not the sole test for patent-eligibility of process claims under §101.

Additionally applicant incorporates by reference, herein, applicant's remarks traversing the §101 rejection in applicant's previously filed response.

For the foregoing reasons, the rejection of claims 3-5 under §101 is overcome and withdrawal of the rejection is in order.

Claim 3 is rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over U.S. Patent 7,338,444 (Ben-Oren) in view of U.S. Patent 6,186,958 (Katzman). Claims 4 and 5 are rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Ben-Oren in view of Katzman and

further in view of GB 2360845 (Ghoos). Reconsideration of the rejections is requested because—contrary to the statement of rejection—Katzman does not meet the exclusionary proviso of the rejected claims.

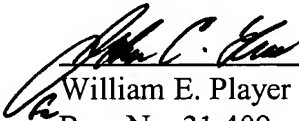
Katzman discloses an apparatus for detecting isotope ratios in the breath of a patient. The apparatus is small and can be used in a physician's office, but its use in a physician's office is not necessary (i.e., not required) according to the reference.

Column 2 of Katzman discloses several applications of the apparatus invention (see items (a) to (j)). No specific test conditions for gastric emptying (item (g)) are described. Assuming a person skilled in the art would consider to use the Katzman apparatus for detection in the method of Ben-Oren, there is no teaching or suggestion in Katzman to exclude from the method of Ben-Oren the body-related factors required by Ben-Oren. In other words, combining the teachings of Ben-Oren and Katzman would, still, have lead the skilled artisan to use the "body-related conversion factors." When combining prior separate prior art references the PTO cannot pick-and-choose only those parts of the references that support a given position to the exclusion of other parts of the references necessary to understand what the reference teaches. Moreover, the mere absence of a negative (exclusionary) teaching from a reference neither teaches nor suggests the negative/exclusionary teaching. Alleged knowledge of one skilled in the art does not justify reading into a reference teachings that simply are not there.

Since a limitation of the rejected claims is not supported by the combined teachings of the cited references, the §103(a) rejection of claim 3, and the §103(a) rejection of claims 4 and 5, are untenable. Withdrawal of the rejections is in order.

Favorable action is requested.

Respectfully submitted,

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